

REMARKS

Upon entry of the present amendment claims 1-11 and 13 are pending in the application. Claims 4 and 5 have been amended to delete multiple dependency.

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

1. Restriction of claims 1-11 and 13 under 35 U.S.C. §121/372 for lack of unity in view of Wilke WO 02/079334; US 2004/0052966 A1

It is the PTO's position that restriction is required between the inventions of Group I, claims 1-11, drawn to a curable powder slurry and Group II, claim 13, drawn to a process for preparing a powder slurry. Restriction is said to be appropriate on the grounds that the claims lack unity of invention.

In particular, the PTO states that the claims lack unity of invention under PCT Rule 13.1, because under PCT Rule 13.1, they lack the same or corresponding special technical feature for the following reasons: the common technical feature of all the claims is not special because it is disclosed in the prior art.

It is the PTO's position that the common technical feature of all the claims is "...the combination of (A) a methacrylate copolymer with at least one isocyanate-reactive functional group and at least one ion forming group, (B) at least one blocked polyisocyanate and (C) at least one pyrazole blocked isocyanate compound with olefinic unsaturation". The prior art relied upon by the PTO and said to disclose the instant inventions of claims 1 and 13 is Wilke, WO 02/079334 and its equivalent US 2004/0052966.

In particular, Preparation Example 1 of Wilke appears to be relied upon for the disclosure of "... (C) a 3, 5 dimethylpyrazole blocked [0338] hexamethylene diisocyanate mixture [0336] containing hydroxyethylacrylate [0336] and thioglycolic acid [0340] corresponding to common technical feature of Groups I and II." (*Office Action of 8/15/08*)

Applicants greatly appreciate the PTO's detailed comments but must respectfully disagree and traverse the restriction requirement.

First, the corresponding special technical feature common to independent claims 1 and 2 is not a combination comprising (A), (B), and (C), wherein (C) is "...at least one pyrazole blocked isocyanate compound with olefinic unsaturation". Rather, the technical feature common to the powder slurry of claim 1 and the process of preparation of claim 13 is the use of a particular component (C) that is olefinically unsaturated and free of isocyanate reactive functional groups and contains on average per molecule, at least one isocyanate group blocked with pyrazole or substituted pyrazole and at least two carbon-carbon double bonds activatable with actinic radiation. Moreover, the required component (C) must have a structure that results from the reaction of a polyisocyanate with *at least one compound that contains an isocyanate reactive functional group and at least two carbon-carbon double bonds activatable with actinic radiation.*

It is respectfully submitted that Preparation Example 1 of Wilke, specifically paragraphs [0336]-[0340], does not disclose a compound satisfying Applicants' requirements for component (C) of claims 1 and 13. Wilke only teaches the reaction of a polyisocyanate with a compound containing a single carbon-carbon double bond that can be activated with actinic radiation, i.e., only the 2-hydroxyethyl of paragraph [0336] provides a carbon-carbon double bond activatable with actinic radiation.

Applicants' particular requirements for component (C) may not be ignored. The use of this particular component in the claimed powder slurry is a 'special technical feature' as that term is defined in MPEP 1893.03(d), i.e., meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

Accordingly, restriction is not permissible under 37 CFR 1.499. Reconsideration and removal of the restriction requirement is respectfully requested.

However, per the requirements of 37 CFR 1.499 and 37 CFR 1.43, Applicants hereby elect the invention of Group I with traverse. If the restriction requirement is maintained, Applicants hereby authorize the cancellation of claim 13 as being drawn to a nonelected invention.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/
Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

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CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
WYANDOTTE, MI 48192
Customer No. 77224

MEG